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JEFFREY S. WHITTLE  
BRACEWELL AND PATTERSON, LLP  
PO BOX 61389  
HOUSTON, TX 77208-1389

EXAMINER

THALER, MICHAEL H

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/580,721

Applicant(s)

HABERLAND ET AL.

Examiner

Michael Thaler

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,9 and 13 is/are allowed.
- 6) ☒ Claim(s) 1,3-6,10-12,14,16 and 17 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/27/06.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: APPENDIX.

The disclosure is objected to because of the following informalities: Reference numeral 25 is absent from the drawings. In claim 4, line 22 and claim 10, line 20 "an alternative or" should be deleted since the second shield stop is claimed as being in addition to rather than as an alternative to the first shield stop. The page 1 of the substitute specification filed Feb, 7, 2005 incorrectly lists this application as being a continuation rather than a continuation-in-part of the parent application. Appropriate correction is required.

Claims 1, 3, 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is confusing and inaccurate since the subject matter recited in lines 5-6 is part of the trocar rather than part of the cannula. Further, in line 21 "an inner surface of the tubular-shaped shield body" has already been recited in lines 16-17, resulting in a double recitation of the same element. Further, in line 18 "a tubular-shaped shield body" has already been recited in lines 16-17, resulting in a double recitation of the same element. The newly presented subject matter of claim 1, as currently amended, is

Art Unit: 3731

incorporated into the claim in the wrong locations. The subject matter in claim 5, lines 1-3 duplicates part of claim 1.

Claims 4, 10-12, 14, 16 and 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shichman (5,104,383). Shichman discloses elongate trocar body 20 with all of the claimed features as shown in the attached appendix including a transition section (defining a shield stop) which is marked by cross-hatching. The Shichman transition region defines a shield stop since proximal movement of the shield will be stopped by the shield stop acting against the compressed spring and shield. Further, the radially outer surface of the proximal portion of the shield will contact the shield stop (marked by cross-hatching) when the shield is retracted. Alternatively, it would have been obvious that the Shichman transition region defines a shield stop for the reason set forth above. As to claim 16, Shichman discloses a pin as shown in the attached appendix. As to claim 17, only the radially outer portion of the right portion of figure 2 of Shichman (i.e., the portion below reference numeral 20) is considered to be the claimed handle (noting that the handle has a slightly smaller distal portion radially recessed from the dashed lines) while only the left half of the radially inner portion (i.e. the left half of the

Art Unit: 3731

portion which surrounds and contacts the spring) is considered to be claimed proximal portion.

Claims 1, 3, 5 and 6 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 7, 9 and 13 are allowed.

Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on Feb. 27, 2006 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3731

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

mht  
4/4/06



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731

APPENDIX

